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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/770,893	02/03/2004	Shihong Gary Song	67097-022	1084
26/096 7590 04/02/2009 CARLSON, GASKEY & OLDS, P.C. 400 WEST MAPLE ROAD SUITE 350 BIRMINGHAM, MI 48009				
EXAMINER KESSLER, CHRISTOPHER S				
ART UNIT		PAPER NUMBER		
1793				
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04/02/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/770,893

Applicant(s)

SONG, SHIHONG GARY

Examiner

CHRISTOPHER KESSLER

Art Unit

1793

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 26-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 26-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Status of Claims

1. Responsive to the amendment filed 17 December 2008, no claim amendments are made to the claims. Claims 1-16 and 26-29 are currently under examination.

Status of Previous Rejections

2. Responsive to the amendment filed 17 December 2008, the rejections based on the prior art are maintained.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1-4, 10-13, 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watson.

Watson is applied to the claims as stated in the Office action of 17 September 2008.

5. Claims 1-5, 7, 8, 10-16, and 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Higashi.

Higashi is applied to the claims as stated in the Office action of 17 September 2008.

6. Claims 1-3, 7-12, 15, 16, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP '911.

EP '911 is applied to the claims as stated in the Office action of 17 September 2008.

7. Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watson in view of Higashi.

Watson in view of Higashi is applied to the claims as stated in the Office action of 17 September 2008.

Response to Arguments

8. Applicant's arguments filed 17 December 2008 have been fully considered but they are not persuasive.

Applicant argues that Er, Yb and Sc are not equivalent elements. This argument is not persuasive. Watson as cited in the Office Action of 17 September 2008 clearly teaches that these elements may be used as the L₁₂ formers. The teaching that Sc is a preferred element does not contradict the fact that Watson teaches that the other elements would serve an equivalent purpose in the aluminum. Preferred embodiments taught by Watson do not constitute a teaching away from the alternatives taught by Watson. Applicant is further directed to MPEP 2123.

Applicant argues in the remarks of 17 December 2008 at page 2, "The teachings of Watson do not appear to extend to compositions that do not include scandium." The examiner disagrees with this statement. Watson as cited previously teaches that X may be a number of elements, more preferably Sc, Er and Lu, and even more preferably Sc. Thus Watson envisions the use of other elements as L₁₂ formers. Again, Watson does not teach away from the use of the elements other than Sc.

Applicant argues that Higashi teaches away from the composition as claimed. The examiner disagrees with this characterization of Higashi. Higashi at col. 2 teaches that the composition of greater than 10% rare earth elements has the same properties as the composition taught by Higashi of 0.5-10.0%, and the additional amount of rare earths is "wasted." This is not a teaching away, as there is no undesirable property or result taught by Higashi for using more than 10% rare earth. One of ordinary skill in the art would have expected the claimed composition to have the same properties as the composition of Higashi, because Higashi says that they will have the same properties.

Applicant argues that the inevitable impurities of aluminum alloys are not "minor alloy elements" as claimed. However, applicant has offered no evidence to support this claim, only arguments.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER KESSLER whose telephone number is (571)272-6510. The examiner can normally be reached on Mon-Fri, 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Roy King/
Supervisory Patent Examiner, Art
Unit 1793

csk